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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,977	01/26/2004	Curt D. Seymour	70026970-0011	9301
26263	7590	10/19/2005		
SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			EXAMINER ROYAL, PAUL	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/764,977

Applicant(s)

SEYMOUR, ET. AL.

Examiner

Paul Royal

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. The Examiner's Election Requirement of 06/16/05 is hereby withdrawn. Claims 1-12 have been examined in the present Office Action.

It is noted that applicant's response to the Examiner's Restriction Requirement included an election of both Group II and Species I which is improper because a selection single Group or Species for prosecution must be made (note: in the present usage species = group). Applicant is advised that adding a secondary election statement (the election of "Species I) to the initial election statement (the election of Group II) has the result of applicant failing to respond to the Restriction Requirement because applicant has effectively attempted to elect both groups. Generally, applicant would receive a second Restriction Requirement and be directed to make a proper election, which may delay prosecution of the application on the merits.

Presently, the Examiner, at the discretion of the Examiner, has decided to withdraw the Restriction Requirements in spite of applicant's non-responsive election, not because of applicant's response. To be clear, applicant is cautioned to avoid using election verbiage which has the net effect of ignoring the Examiner's Restriction Requirement. Further applicant should not take the present withdrawal of the Restriction Requirement to suggest that applicant adequately responded to the Restriction Requirement.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

Applicant states in the specification that "a preferred embodiment of the instant invention is described, in part, with reference to Figures 1 and 2 showing the display and the storage system of the prior art."

However, applicant does not clearly distinguish the elements of the instant invention from the admitted prior art. The Examiner cannot determine what components are considered part of applicant's invention and what components are considered part of the prior art.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 7, the term "type" renders the claim indefinite because it is unclear what limitations are part of the claimed invention. See MPEP § 2173.05(d).

Specifically, the album components applicant considers part of the invention must be recited.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (US 6,694,683).

Anderson et al. teaches sight glass retainer system comprising;  
a frame (22), said frame including a lip (50);  
a transparent display panel (38) supported within a front side of said frame by said lip;

an single piece spacer (40) positioned within said frame (22) on an opposing side of said panel (38) to said lip (50), the spacer having a width smaller than the width of the lip and an inner circumference similar to an outer circumference of the lip; and

a backing (12) positioned on an opposing side of said spacer (40) to said panel (38), said backing (12) adapted to maintain said spacer (40) and said panel (38) within said frame (22) from a back side of said frame, see column 3, lines 49-53 and column 4, lines 32-36, the backing (12) including a matting component (16) and a backing component (14).

Note, the method of making the single piece spacer such as injection molding is not given patentable weight in the apparatus claim where the structure of the prior art anticipates the claimed invention even though the structure can be made from a different method. In the instant case, the single piece spacer can be made by hot stamping or cutting the spacer from existing material and it would still anticipate the claimed invention because it includes the same structure as the claimed invention.

6. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Baermann (US 3,456,374).

Baermann teaches a method of manufacturing a spacer (44) for providing a gap between a display panel (30) and a backing (22) in a three dimensional custom display system, comprising the steps of:

determining an inner circumference of the display system; and injection molding a single piece body, said body including an outer circumference that fits within said inner circumference of the display system, see column 2, line 64 to column 3, line 13.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanley et al. (US 6,460,279) in view of Tsai (US 5,662,447).

Stanley teaches a custom display and storage system comprising:

a display unit (16) having an opening (30, 32), said opening adapted for display of an image (80) or character string (76);

a customizable insert assembly (22) adapted for display of an image or character string,

said insert assembly including a base sheet (50), the base sheet including guidelines (62, 64) for alignment of the image or character string,

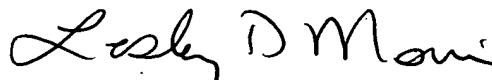
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a releasable backing connection (18) and slot (40) between said display unit (16) and said insert assembly (22) adapted to removably mount said insert assembly to said display unit, and a storage unit (14) coupled with said display unit.

Stanley et al. does not show a matting including a cut out, corresponding to said opening of said display unit, or the alignment of matting image/character string with the base sheet or the backing coupled to the display unit via a hinge.

Tsai teaches a front cover mountable with a photograph for books having a display unit (Display Unit, see Examiner's annotated Figure 2) having a hinged (11) backing (Backing, see Examiner's annotated Figure 2) and matting (Matting, see Examiner's annotated Figure 2) including a cut out (12) corresponding to a cover opening (21) of the book cover (2) and the alignment of the alignment of cut-out and opening, to provide a front-cover mountable with a photo to give a book a unique impression.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the custom display and storage system of Stanley to include having a display unit including a hinged backing and having matting including a cut out which corresponds to a cover opening of a book cover and the alignment of the alignment of cut-out and opening, to provide a front-cover mountable with a photo to give a book a unique impression.



**LESLEY D. MORRIS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**



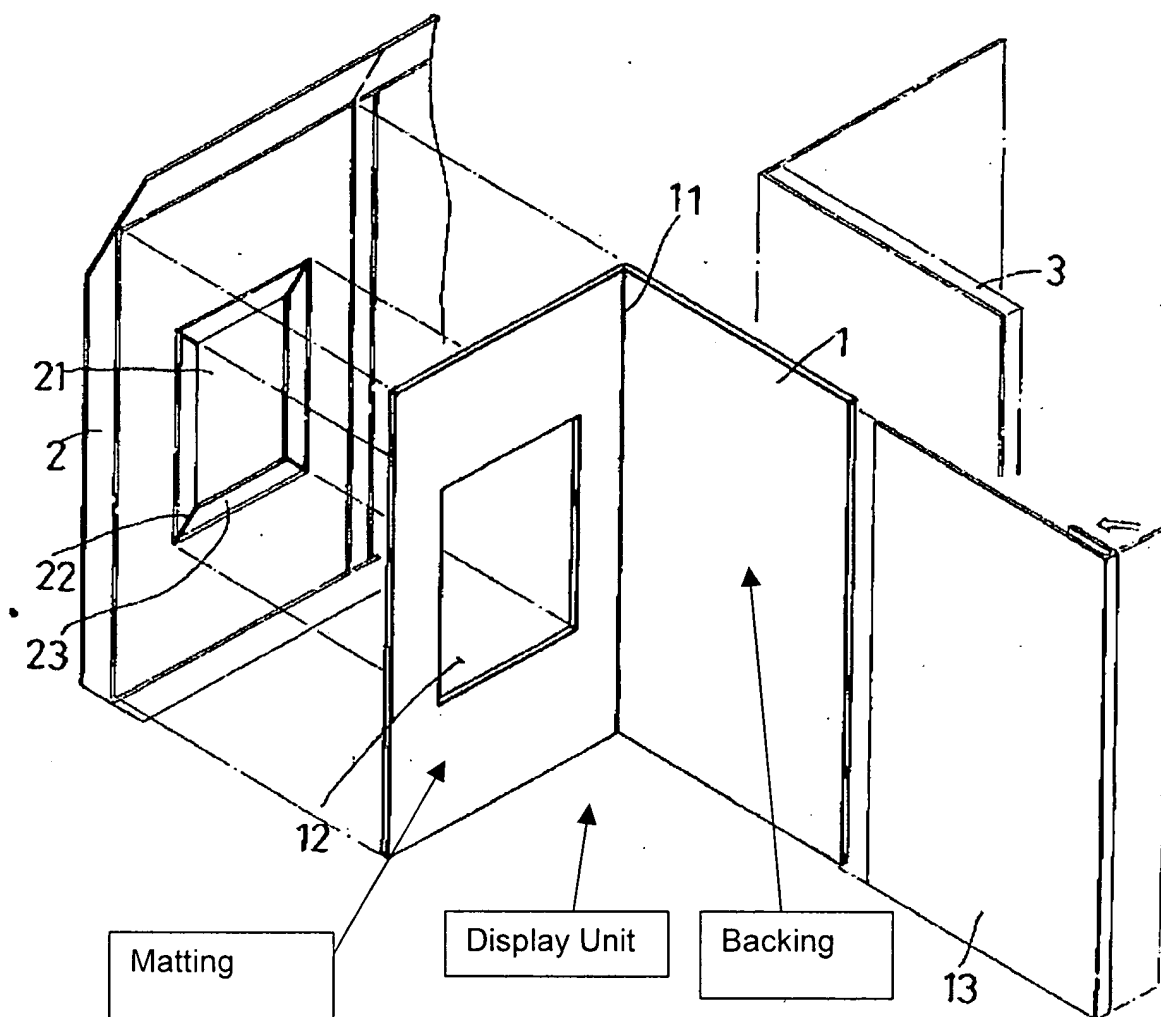


FIG.2

**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Holson teaches a photo album cover with framed insert. Huang et al. teaches an album cover with replacement front cover. Suesholtz teaches frames for pictures. Stanley teaches a custom display system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 571-272-6652. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Royal  
Examiner  
Art Unit 3611

P. Royal  
10/17/2005